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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,871	12/16/2003	William Sobonya	MAEE 2 00039	5400
27885	7590	09/16/2005	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,871	Applicant(s) SOBONYA, WILLIAM	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/3/04</u> . | 6) <input type="checkbox"/> Other: ____ |



Art Unit: 1771

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, independent claims 1 and 12 are confusing in that they each recite a textured finish embossed "to one side" of the film and then in the next line refer to "a bottom side" of the same film; the Examiner suggest that "to one side" might desirably be changed to --one of a top or bottom side--, or similar language so as to eliminate any possible confusion. In claims 10 and 12, line 3 of each, the phrase "to an approximate size" has no suitable standard to refer to and thus is vague and indefinite.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Rusincovitch et al '220 or Rusincovitch, Jr et al '929, each taken individually, or alternatively each taken in view of applicant's admissions on page 1, paragraph 0001 of the specification. The references each disclose (note particularly the '220 patent, Figures 1, 2A, 2B, 4A, Col 1, lines 9-30, Col 4, line 61-Col 5, line 6, line 63-Col 6, line 3, Col 7, lines 28-36, lines 57-61, Col 11, lines 13-23; the '929 patent, Figure 2, Col 1,

Art Unit: 1771

lines 20-35, Col 3, lines 8-18, lines 34-39, Col 4, lines 2-10, Col 5, lines 34-40, lines 47-54, lines 61-65), in certain embodiments, substantial anticipations of at least applicant's broad article claim which includes a decorative covering for a desired surface, the covering having a plastic film such as PVC which has on one surface an embossed decorative "textured finish" and which is coated on its lower surface with a suitable pressure sensitive adhesive, i.e. a contact adhesive. Additionally, the utilization of removable protective coverings, i.e. release sheets, are also mentioned in each reference. With respect to the performance limitation that the adhesive (claims 1, 12) "adapts to a contour of said edge without leaving a gap between said contact adhesive and said article", this is believed to be an inherent property of the article if utilized in the edge covering manner stated in the defacto "wherein" clause. With respect to the method claims 10 and 12 these are essentially believed to recite nominal methods of use, and such process parameters as "trimming" the cover, "stretching" the cover in preparation for adhering it to a desired surface, and "contacting" the article to the second surface of the article to be covered are each believed to be, if not expressly taught or inherently disclosed, obvious techniques for one of ordinary skill. With respect to the combination rejections which employ the admissions regarding the state of the art in the first paragraph of the Background of the Invention section, note that such adhesive sheets coated with contact adhesive are cut to a desired size before application to a surface to be covered, such as a shelf or tabletop. With respect to the dependent claims not specifically discussed above, such parameters as the coating between the adhesive and the cover found in claim 4, and thicknesses of the film such

Art Unit: 1771

as are set forth in claim 8 are each also believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
Art Unit 1771

